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Federal Agencies

July 31, 2002

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Commissioner for Patents
Washington, D.C. 20231

Group Art Unit 1626

Re: U.S. Patent Application
Appl. No. 09/814,123; Filed: March 22, 2001
For: **Aryl Substituted Pyrazoles, Triazoles and Tetrazoles, and the Use
Thereof**
Inventors: Hogenkamp *et al.*
Our Ref: 1861.1270001/JMC/THN

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to Restriction and Election of Species Requirements; and
2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents

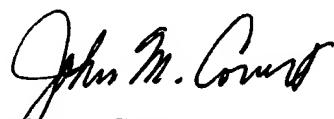
July 31, 2002

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The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



John M. Covert
Attorney for Applicants
Registration No. 38,759

Enclosures

SKGF_DCI:40245.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hogenkamp *et al.*

Appl. No.: 09/814,123

Filed: March 22, 2001

For: **Aryl Substituted Pyrazoles, Triazoles and Tetrazoles, and the Use Thereof**

Confirmation No. 2060

Art Unit: 1626

Examiner: Shameem, G.

Atty. Docket: 1861.1270001/JMC/THN

Reply To Restriction and Election of Species Requirements

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated July 1, 2002 (PTO File Wrapper Paper No. 9),
Applicants submit the following Remarks.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Remarks

The Examiner has required restriction to one of six groups of inventions, Groups **I-VI**, under 35 U.S.C. § 121. Group **I**, represented by claims 1-14 and 17, is drawn to a compound and composition of Formula **I**. Group **II**, represented by claims 1, 15-17 and 24, is drawn to a compound and composition of Formula **I**. Group **III**, represented by claims 18-21 and 27, is drawn to a method of treating a disorder. Group **IV**, represented by claims 22-23, is drawn to a compound of Formula **I**. Group **V**, represented by claim 25, is drawn to a compound of Formula **I**. Group **VI**, represented by claim 26, is drawn to a compound of Formula **I**. The Examiner has also requested an election of a single disclosed species under 35 C.F.R. § 121.

Applicants hereby provisionally elect to prosecute the invention of Group **I** (claims 1-14 and 17) which is drawn to compounds of Formula **I**. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

In addition, Applicants provisionally elect the species 1-(4-phenoxyphenyl)-1H-pyrazole-3-carboxamide, prepared in Example 2, at paragraphs [0128] and [0129] of the specification as originally filed. Claims 1-11 and 15-25 read on this species.

Both elections are made **with** traverse.

M.P.E.P. § 803 (Eighth Edition, August 2001), at page 800-4, left hand column, states as one of the criteria for a proper requirement for restriction that: "There must be a serious burden on the examiner if restriction is required ...". Thus, the Patent Office encourages the search and examination of an entire application on the merits, where such

search and examination can be made *without* serious burden. Further, different classification or separate commercial data base and automated patent system (text) searches are not a proper standard for restriction requirement.

In the present case, Applicants respectfully assert that the search of restriction Groups **I-VI** does not impose a serious burden upon the Examiner, as a search concerning the patentability of the invention of one group will clearly uncover art of interest to the other groups. At least, the search of restriction Groups **I**, **II**, and **IV** does not impose a serious burden to the Examiner, since the invention of Group **I** is generic to inventions of Groups **II** and **IV**. Search required for Groups **II** and **IV** is required for Group **I**. Further, Applicants submit that the search of Group **I** and Group **VI** in part, as far Group **VI** includes compounds of Group **I** that are ³H or ¹⁴C radiolabeled, would not present an undue burden to the U.S.P.T.O.

Further, restriction practice is not applicable to a single claim. See *In re Weber*, 198 U.S.P.Q. 332 (C.C.P.A. 1978) and its companion case, *In re Haas*, 198 U.S.P.Q. 334 (C.C.P.A. 1978). These cases make it clear that 35 U.S.C. § 121 does not grant to the U.S. Patent and Trademark Office (PTO) the authority to refuse to examine a single claimed invention. Section 121 only applies to *plural* claimed inventions in *different* claims, wherein the different claims vary not just in scope, but in the invention to which each is directed.

Thus, Applicants submit that in the present case, restriction to one of six groups of inventions, as required by the Examiner, is improper. Therefore, the claims of Groups **I-VI** should be examined together. Applicants respectfully request that at least the claims of

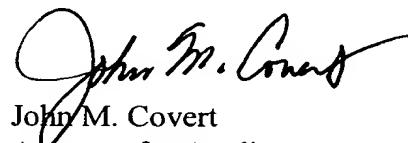
Hogenkamp *et al.*
Appl. No.: 09/814,123

Groups **I**, **II**, **IV**, and **VI** (in part as far Group **VI** includes compounds of Group **I** that are ³H or ¹⁴C radiolabeled) be examined together.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



John M. Covert
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Date: July 31, 2002

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Applicants: Hogenkamp *et al.*

Due Date: August 1, 2002

Art Unit: 1626

Examiner: Shameem, G.

Docket: 1861.1270001

Atty: JMC/THN

Application No.: 09/814,123

Filed: March 22, 2001

For: Aryl Substituted Pyrazoles, Triazoles and Tetrazoles, and the Use Thereof

When receipt stamp is placed hereon, the USPTO acknowledges receipt of the following documents:

1. SKGF Cover Letter;

Applicants: Hogenkamp *et al.*

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